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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/758,280

01/16/2004

Alain Tornier

14588

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7590

05/16/2006

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EXAMINER

HOFFMAN, MARY C

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,280

Applicant(s)

TORNIER ET AL.

Examiner

Mary Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: ref. #'s 66' and 72'. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 3 is objected to because of the following informalities: In claim 3, line 2, there appears to be a grammar mistake, the word "of" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 15, "and/or" is indefinite because it is unclear what limitation such language places on the claimed subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kashuba (WO 94/21199).

Kashuba et al. disclose embodiments of an ancillary tool comprising a handle adjacent a distal end of the tool with a head (bottom portion of ref. #22/24), and a proximal part (ref. #70) with a surface for application of a force along the handle (ref. #72), an endpiece (ref. #12) capable of being removably connected to the distal end of the handle. The endpiece includes an elastically deformable ring (see Abstract, ref. #19, 44, 46) that is capable of being moved both radially outward by force and radially

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inwardly when the force is relieved relative a longitudinal axis of the handle. [With regard to this statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Kashuba which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The elastically deformable ring of Kashuba, which is made of a resilient material, is capable of being moved radially outwardly by force (such as the surgeon pushing outwardly on the springs ref. #19) and returning to an undeflected state when the force is removed.] The endpiece comprises an outer face to engage the inner surface of an acetabulum, and an inner surface to interact with the head of handle. Force is applied to urge the head into engagement with the inner face of the endpiece, and the elastically deformable ring expands radially to wedge with the inner surface of the acetabulum to permit manipulation and placement of the acetabulum (see page 11, lines 1-2). The ring (ref. #19, 44,46) is elastically deformable over substantially an entire periphery, and the outer surface of the deformable ring (outside portion of ref. #19) constitutes substantially an entire surface of the endpiece. The elastically deformable ring constitutes a plurality

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of petals, the inner and outer faces being constituted by the inner and outer faces of the petals. In another embodiment, the endpiece includes a supple part (ref. #19) and a rigid part (ref. #200'''), the rigid part including means for removably connecting the endpiece to the distal end of the handle (see central hole in ref. #200'''). The rigid piece defines a stop surface in the longitudinal direction (ref. #54). The rigid part (ref. #200''') is secured to the supple part includes a generally hemispherical base (see insert of Fig. 17) to which the deformable ring is elastically connected.

Moreover, in a second interpretation of independent claim 1, one can also consider the endpiece as ref. #12, including components denoted by ref. #16, #19, #52 to be the "elastically deformable ring", and the elastically deformable ring would be capable of being moved both radially outward by force and radially inwardly when the force is relieved relative a longitudinal axis of the handle via the mechanism denoted by ref. #52). The endpiece comprises an outer face to engage the inner surface of an acetabulum, and an inner surface to interact with the head of handle. Force is applied to urge the head into engagement with the inner face of the endpiece, and the elastically deformable ring expands radially to wedge with the inner surface of the acetabulum to permit manipulation and placement of the acetabulum (see page 11, lines 1-2). The endpiece includes a supple part (ref. #19) and a rigid part (ref. #16), the rigid part including means for removably connecting the endpiece to the distal end of the handle (ref. #20). The rigid piece defines a stop surface in the longitudinal direction (ref. #54). The supple part of the endpiece presents at least one surface for the transmission of the force between the handle and the acetabulum.

Claims 1 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kashuba (WO 94/21199).

Kashuba et al. disclose embodiments of an ancillary tool comprising a handle adjacent a distal end of the tool, with a head (ref. #70), and a proximal part of the head is a surface for application of a force along the handle (ref. #72), an endpiece (ref. #12) capable of being removably connected to the distal end of the handle. The endpiece includes an elastically deformable ring (ref. #12, including #16, #19, #52) that is capable of being moved both radially outward by force and radially inwardly when the force is relieved relative a longitudinal axis of the handle via the mechanism denoted by ref. #52. The endpiece comprises an outer face (surface facing the acetabulum) to engage the inner surface of an acetabulum, and an inner surface (the inner surfaces are **not** facing down, or not facing the acetabulum) to interact with the head of handle (see FIG. 6). Force is applied to urge the head into engagement with the inner face of the endpiece, and the elastically deformable ring expands radially to wedge with the inner surface of the acetabulum to permit manipulation and placement of the acetabulum (see page 11, lines 1-2). The head of the handle comprises a ramp surface to cooperatively engage the inner face of the endpiece (inside stepped surface of ref. #70, page 11, lines 24-26). The handle includes a rigid rod (ref. #22/24) on which the head (ref. #70) is movably mounted as well as means for driving the head with respect to the rod in a movement of translation in a longitudinal direction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kashuba (WO 94/21199).

Kashuba discloses the claimed invention except for the rigid part (ref. #200") being metallic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Kashuba with the rigid part (ref. #200") being metallic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

Claim 14 is allowable. Claims 12 and 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER